



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JACQUES M DULIN
Innovation Law Group, Ltd.
224 W. Washington St.
NetPort Center, Suite 201
Sequim, WA 98382-3338

COPY MAILED

FEB 24 2005

OFFICE OF PETITIONS

In re Application of	:	
Weiglhofer et al.	:	
Application No. 09/199,888	:	
Filed: November 24, 1998	:	ON PETITION
Title of Invention:	:	
3D STEREO REAL-TIME SENSOR	:	
SYSTEM, METHOD AND COMPUTER	:	
PROGRAM THEREFOR	:	

This is a decision on the Request for Reconsideration of Petition for Revival Under 37 CFR 1.137(a) petition under 37 CFR 1.137(a), filed August 10, 2004, to revive the above-identified application based upon unavoidable abandonment of the application, and on the alternative petition under 37 CFR 1.137(b), based upon unintentional abandonment.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

Background

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Notice of Allowability, mailed February 14, 2001. The Notices set a non-extendable statutory period for reply of three (3) months. No reply having been received, the above-identified application became abandoned May 15, 2001. A Notice of Abandonment was mailed on April 29, 2004.

Applicant filed petitions under 37 CFR 1.137(a) and (b), to revive the application based upon unavoidable and unintentional abandonment respectively. Applicant asserted that the Office improperly abandoned the application. The Office mailed a Notice of Allowance and Notice of Allowability on October 2, 2000. In response to the

Notices, Applicant filed a CPA on December 18, 2000, in order to bring to the attention of the Examiner an Information Disclosure Statement ("IDS"). Applicant alleges that the application should not have been abandoned because of the CPA filing.

The petitions were dismissed because Office records revealed that, in response to the CPA, Applicant received Notices of Allowance and of Allowability, mailed February 14, 2001. Applicant was advised that it was the failure to timely and properly respond to the February 14, 2001, Notices that resulted in the Abandonment of the application, and not the failure to respond to the Notices mailed October 2, 2000. A review of the application file and the Notice of Allowability reveal, while an authorization to charge Applicant's deposit account, no. 08-1641, was in the application file, applicant failed to timely submit formal drawings in response to the Notice of Allowability.

Petition under 37 CFR 1.137(a) for unavoidable abandonment

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks items (1) and (3).

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.¹ 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee ... at any time ... if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." (emphasis added).

"In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")).

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F.3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1787 (Fed. Cir. 1995) (citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm'r Pat. 1990; Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982)). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)). However, "The question of

¹ The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."² Nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.³ The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Applicant is further advised that the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

² Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

³ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, **or their own**, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

Finally, a "delay (in responding) resulting from the lack of knowledge or improper application of the patent statute, rules of practice, or MPEP, [] does not constitute unavoidable delay." MPEP 711.03(c).

The instant Requests for Reconsideration

Applicant files the instant requests for reconsideration and as an initial matter, notes that the Decision dismissing the petitions, mailed November 22, 2004, references as part of a response to the dismissal, that the reply may include an oath or declaration executed by the non-signing inventor. Applicant is advised that this sentence is the result of a transcription error and should not have been included in the Decision dismissing the petitions.

Regarding the merits of the abandonment of the application and its revival, Applicant avers that the Notices mailed February 14, 2001, were mailed to the wrong address. Applicant states the CPA, filed December 18, 2000 included clear instructions to address all future correspondence to a new correspondence address.

Analysis of the instant petition

A review of the application file and of the CPA filing reveal that the CPA filing consisted of four (4) pages. On page three (3) of the filing Applicant included the request to address all future written and telephone correspondence to a new correspondence address and/or telephone number.

Applicable Law

Applicant is advised that 37 CFR § 1.4, Nature of correspondence and signature requirements, provides that

(c) [s]ince different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 CFR § 1.4(c)

In this instance, page three was a continuation of page two under the heading of "Further Instructions and Information:",

under which included, just prior to listing the instructions regarding the correspondence address and/or telephone number, information regarding a priority claim. The heading was in bold letters and underlined.

The instructions regarding the correspondence address and/or telephone number were emboldened but not underlined.

Immediately after the instructions regarding the correspondence address and/or telephone number, Applicant included a heading on page three entitled "Fee Payment and Deposit Account Information". Again, the heading was in bold letters and underlined. Page three continued on listing fee payment information.

Here, Applicant failed to comply with 37 CFR 1.4(c) and present each distinct subject, inquiry or order in a separate paper.

As to item (3), Applicant has not provided an adequate showing of unavoidable delay. Applicant is reminded that a "delay (in responding) resulting from the lack of knowledge or improper application of the patent statute, rules of practice, or MPEP, [] does not constitute unavoidable delay." MPEP 711.03(c). Applicant failed to comply with 37 CFR 1.4(c) and present each distinct subject, inquiry or order in a separate paper.

Conclusion

Accordingly, the petition under 37 CFR 1.137(a) is dismissed.

Petition under 37 CFR 1.137(b) for unintentional abandonment

With the instant petition Applicant has submitted the issue fee and corrected formal drawings were filed March 16, 2001. Deposit account 04-1699 has been charged \$700.00 for the issue fee as authorized in the instant petition.

Request for Adjustment of Patent Term

Applicant also requests an adjustment of the patent term under 35 U.S.C. § 154(b). Applicant is advised that Patent Term Extensions (as opposed to patent term adjustments) are available for applications filed after June 8, 1995 and before May 29, 2000. The appropriate avenue for relief is via a petition under 37 CFR 1.181. The MPEP provides

If applicant disagrees with the patent term extension information printed on the Notice of Allowance and Fee(s) Due, applicant may request review by way of a petition under 37 CFR 1.181. To avoid loss of patent term, however, any such petitions filed during the pendency of the application will not be decided until after issuance of the patent.

MPEP 2720

A review of the Notice of Allowance and Issue Fee Due, mailed February 15, 2001, indicates a 35 U.S.C. [§] 154(b) patent term extension of 0 days. As noted above, Applicant should file a petition under 37 CFR 1.181 requesting review of the patent term. Accord 37 CFR 1.4(c). The petition will not be decided until after issuance of the patent.

Accordingly, the request for an adjustment to the patent term is **dismissed as inappropriate.**

This application is being forwarded to Publishing Division for processing into a patent.

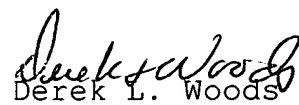
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to Petitions Attorney Derek L. Woods at (571) 272-3232.


Derek L. Woods
Attorney/Advisor
Office of Petitions